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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,235	03/19/2001	Franklin Goodhue Woodward	WVANP012	3417
22434	7590	10/27/2003	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			JAKETIC, BRYAN J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,235

Applicant(s)

WOODWARD ET AL.

Examiner

Bryan Jaketic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 7, 11, 13-15, 30, 31, 35, 37-39, 45-51, 57-63, 67, 71, and 73-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Breen, Jr. et al. Breen, Jr. et al discloses a system and method for implementing e-commerce transactions via a network (20) comprising: identifying a regulated item that satisfies a predetermined criteria, wherein the predetermined criteria indicates that the item is prohibited from being purchased by the customer (see col. 1, lines 15-57); and taking action to prevent the purchase of the regulated item (245). The action is automatically implemented by a system server (see Figures 1 and 3). The predetermined criteria include a regulation parameter that corresponds to regulations that restrict sales and deliveries to a particular jurisdiction (see Fig. 7). The action comprises steps to prevent completion of checkout (see col. 10, lines 16-36). Breen, Jr. et al further disclose an inventory subsystem (16b), a customer interface (12), and an order fulfillment subsystem (23).

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3. Claims 1-3, 6, 8, 11, 13-15, 30, 31, 34, 36-39, 42, 45-47, 49-51, 54, 57-59, 61-63, 66, 68, and 71-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo et al. Matsuo et al disclose a system and method for implementing e-commerce via a network (10) comprising identifying a regulated item selected by a customer, wherein the item satisfies a predetermined criteria indicating that the item is prohibited from being purchased by the customer in a particular jurisdiction (paragraph 110); and automatically taking action to prevent the customer from completing a checkout operation for the regulated item (see paragraphs 111-112). The product is an alcohol product, and the predetermined criteria correspond to regulations that restrict the sales to persons under a minimum age.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9, 10, 12, 16, 17, 21, 23, 24, 28, 43, 44, 55, 56, 69, 70, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breen, Jr. et al. Breen, Jr. et al disclose all of the limitations listed in paragraph 4 of this Office Action. Breen, Jr. et al do not teach the steps of restricting display of an item, preventing the customer from adding the item to a cart, or removing the item from a cart. However, Breen, Jr. et al teach a registration process for potential buyers (see Fig. 10A-F) and a login screen for allowing users to enter a "Secured For Trade" portion of the web site (Fig. 11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to only display items for which a person is authorized to purchase for security purposes. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prevent a customer from adding a restricted item to his cart, or removing such an item from his cart to facilitate checkout.

7. Claims 9, 10, 12, 16, 17, 20, 22-24, 27, 29, 43, 44, 55, 56, 69, 70, and 72 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. Matsuo et al disclose all of the limitations listed in paragraph 5 of this Office Action. Matsuo et al do not teach the steps of restricting display of an item, preventing the customer from adding the item to a cart, or removing the item from a cart. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement any of these steps to facilitate checkout.

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8. Claims 4, 5, 18, 19, 25, 26, 32, 33, 40, 41, 52, 53, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al as applied to claims 1, 16, 23, 30, 37, 49, and 61 above, and further in view of Tracy et al. Matsuo et al disclose all of the limitations of the claims except for regulations restricting sales during specific days. Tracy et al disclose a checkout system that automatically prohibits the sale of items during specific days (see col. 13, line 57 through col. 14, line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Tracy et al with the invention of Matsuo et al to ensure that the system complies with existing laws.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsuria et al disclose a system for preventing minors from viewing items. Harms et al discloses a cash register for preventing sale of restricted items to minors.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj



10/24/03